



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,005	12/05/2001	James Burke	4851.01	2854

37833 7590 06/20/2005

LITMAN LAW OFFICES, LTD
PO BOX 15035
CRYSTAL CITY STATION
ARLINGTON, VA 22215

EXAMINER

MENBERU, BENIYAM

ART UNIT	PAPER NUMBER
----------	--------------

2626

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/002,005

Applicant(s)

BURKE, JAMES

Examiner

Beniyam Menberu

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 6 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f),
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/5/2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed Action

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: reference 30 in Figure 2; reference 52, Figure 3; reference 90, Figure 4A; reference 140, Figure 6. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Applicant is advised that should claims 6 and 20 be found allowable, claims 6 and 20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after

allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 4 recites the limitation "said confirmation device" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 11, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5764371 to Kawashima et al.

Regarding claims 1 and 11, Kawashima et al disclose a confirming FAX machine/method comprising:

Art Unit: 2626

- a) means for scanning each page of a document and sending the information scanned electronically to a receiving FAX machine (Figure 12, step 102, 103, 106; column 8, lines 63-67; column 9, lines 1-7, lines 22-26); and
- b) means for marking each page of a document scanned and sent by said FAX machine with an ink message (column 9, lines 27-32).

Regarding claim 15, Kawashima et al disclose a FAX confirmation device comprising means for marking each page of a document scanned and sent by said FAX machine with an ink message (column 9, lines 27-32), said FAX confirmation device being adapted for attachment with a FAX machine at a point past the output of the scanner of said FAX machine (Figure 4, the marking device (reference 10a-b) is located after the scanning elements (9a-b) (column 6, lines 17-25)).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 12, 13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5764371 to Kawashima et al in view of U.S. Patent No. 5867586 to Liang.

Regarding claims 2, 12, and 16, Kawashima et al teaches all the limitations of claims 1, 11, and 15 respectively. Kawashima et al disclose marking to confirm the

Art Unit: 2626

sending of said each page of said document (column 9, lines 40-44). However Kawashima et al does not disclose the confirming FAX machine of claim 1, wherein said ink message is printed with an invisible ink which is only visible in the UV spectrum; and further comprising means for reading said marking to confirm the sending of said each page of said document.

Liang disclose wherein said ink message is printed with an invisible ink which is only visible in the UV spectrum (column 4, lines 20-30); and further comprising means for reading said marking (Figure 1, reference 10; column 5, lines 51-55).

Kawashima et al and Liang are combinable because they are in the similar problem area of marking of documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the invisible ink marking of Liang with the system of Kawashima et al to implement invisible marking of facsimile documents.

The motivation to combine the reference is clear because Liang teaches that for security purpose special markings are needed (column 1, lines 53-67).

Regarding claim 13, Kawashima et al in view of Liang teach all the limitations of claim 12. Further Liang discloses the method of claim 12, further comprising the step of reading each marking under a UV lamp to confirm that said page was scanned and sent (Figure 1, reference 10; column 5, lines 51-55).

10. Claims 3 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5764371 to Kawashima et al in view of U.S. Patent No. 5867586 to Liang further in view of UK Patent Application No. GB 2342434 A to Taylor.

Regarding claims 3 and 17, Kawashima et al in view of Liang teach all the limitations of claims 2 and 16 respectively. However Kawashima et al in view of Liang does not disclose the confirming FAX machine of claim 2, wherein said means for reading said marking is a low power UV pen light.

Taylor discloses a low power UV pen light which can be used to read markings (page 2, lines 1-4; page 5, lines 3-5; page 7, line 28).

Kawashima et al, Liang, and Taylor are combinable because they are in the similar problem area of marking of documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the UV pen light reader for reading of marking provided by the system of Kawashima et al in view of Liang.

The motivation to combine the reference is clear because Taylor teaches that portable UV pen light is useful and less power consuming (page 1, lines 25-30, page 2, lines 1-10).

11. Claims 4 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5764371 to Kawashima et al in view of U.S. Patent No. 5867586 to Liang further in view of U.S. Patent No. 4777510 to Russel.

Regarding claims 4 and 18, Kawashima et al in view of Liang teach all the limitations of claims 2 and 16 respectively. Further Kawashima et al disclose the confirming FAX machine of claim 2, wherein said FAX machine comprises a document output tray for receiving said each page of said document sent (Figure 4, reference 11; column 1, lines 40-46). However Kawashima et al in view of Liang does not disclose

Art Unit: 2626

said confirmation device further comprising a low power UV light so mounted on said FAX machine as to illuminate said marking on each said page of said document as it enters said document tray.

Russel disclose confirmation device further comprising a low power UV light so mounted on said FAX machine as to illuminate said marking on each said page of said document as it enters said document tray (Figure 3a, reference 83; column 4, lines 15-25).

Kawashima et al, Liang, and Russel are combinable because they are in the similar problem area of marking of documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the UV light source of Russel with the system of Kawashima et al in view of Liang to implement UV light source used for reading of invisible markings.

The motivation to combine the reference is clear because the source of UV light is internal to the device therefore there is no need for external UV sources which makes it convenient for the users.

12. Claims 5, 6, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5764371 to Kawashima et al in view of U.S. Patent No. 5923763 to Walker et al further in view of U.S. Patent No. 5465167 to Cooper et al.

Regarding claims 5, 14, and 19, Kawashima et al teaches all the limitations of claims 1, 11, and 15 respectively. However Kawashima et al does not disclose the confirming FAX machine of claim 1, wherein said marking means is a printer for marking

Art Unit: 2626

data, such as date, time the FAX is sent, and telephone number to which the FAX is sent.

Walker et al disclose marking means which is a printer for marking data, such as date, time the FAX is sent (column 1, lines 29-35; column 3, lines 35-45; column 4, lines 6-19).

Cooper et al disclose marking of telephone number to which the FAX is sent (column 6, lines 19-25).

Kawashima et al, Walker et al, and Cooper et al are combinable because they are in the similar problem area of marking of documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the markings of Walker et al and Cooper et al with the system of Kawashima et al to implement date/time and destination number markings on facsimile documents.

The motivation to combine the reference is clear because date and destination markings can be useful for organization purpose for transmission of multiple documents by facsimile.

Regarding claim 6, Kawashima et al in view of Walker et al disclose the confirming FAX machine of claim 5, further comprising a printer controller for receiving electrical signals representing time, date, and FAX number from said FAX machine and controls said printer by sending corresponding electrical control signals to said printer (Figure 1, reference 24; column 8, lines 48-57).

Art Unit: 2626

13. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5764371 to Kawashima et al in view of U.S. Patent No. 5923763 to Walker et al further in view of U.S. Patent No. 5465167 to Cooper et al further in view of U.S. Patent No. 6522426 to Park.

Regarding claim 7, Kawashima et al in view of Walker et al further in view of Cooper et al teach all the limitations of claim 6. However Kawashima et al in view of Walker et al further in view of Cooper et al does not disclose the confirming FAX machine of claim 6, wherein said printer controller is programmed to scroll the carriage of said printer down a line at a time for each page faxed until programmed to return to the top of a page, whereby the chances of overwriting a confirmation marking made when previously FAXED is significantly reduced.

Park discloses print controller programmed to scroll the carriage of said printer down a line at a time for each page faxed until programmed to return to the top of a page, whereby the chances of overwriting a confirmation marking made when previously FAXED is significantly reduced (column 3, lines 62-67; column 4, lines 45-67; column 5, lines 1-10).

Kawashima et al, Walker et al, Cooper et al, and Park are combinable because they are in the similar problem area of marking of documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the programmable marking of Park with the system of Kawashima et al in view of Walker et al further in view of Cooper et al to implement multiple markings of a single document.

The motivation to combine the reference is clear because Park teaches that marking can be used for determining the status of scanned document (column 2, lines 28-67).

Regarding claim 8, Kawashima et al in view of Walker et al further in view of Park teach all the limitations of claim 6. Further Walker et al disclose the confirming FAX machine of claim 7, wherein said printer is an ink jet printer (column 10, lines 22-26).

14. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5764371 to Kawashima et al in view of U.S. Patent No. 5923763 to Walker et al further in view of U.S. Patent No. 5465167 to Cooper et al further in view of U.S. Patent No. 6522426 to Park further in view of U.S. Patent No. 4590486 to Yana.

Regarding claim 9, Kawashima et al in view of Walker et al further in view of Park teach all the limitations of claim 7. However Kawashima et al in view of Walker et al further in view of Park does not disclose the confirming FAX machine of claim 7, wherein said printer is a thermal process printer.

Yana disclose thermal process printer for facsimile device (column 11, lines 10-20).

Kawashima et al, Walker et al, Cooper et al, Park, and Yana are combinable because they are in the similar problem area of marking of documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the thermal processing printer of Yana with the system of Kawashima et al in view of Walker et al further in view of Cooper et al further in view of Park to implement thermal marking of documents.

The motivation to combine the reference is clear because thermal process provides for efficient use of ink as taught by Yana (column 2, lines 45-55).

Regarding claim 10, Kawashima et al in view of Walker et al further in view of Park further in view of Yana teach all the limitations of claim 9. Further Yana disclose the confirming FAX machine of claim 9, wherein said thermal process printer comprises a print engine, having a pressing roller which presses the document against a ribbon coated with invisible ink, and a printer head on the opposite side of the ribbon and document which melts small dots of the ink which are pressed against the document to form said markings (column 11, lines 10-33).

Other Prior Art Cited

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6628412 to Jeran et al disclose document management system.

U.S. Patent No. 5818606 to Muramatsu et al disclose digital copier.

U.S. Patent No. 4300169 to Sato disclose facsimile method.

U.S. Patent No. 4301479 to Fukinuki et al disclose signal processor.

U.S. Patent No. 5497250 to Kawashima disclose document scanner.

U.S. Patent No. 6188766 to Kocher disclose timestamping of transmission data.

U.S. Patent No. 4511902 to Nagashima disclose thermal printers.

U.S. Patent No. 5625467 to Kurokawa disclose facsimile apparatus.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 2626

For more information about the PAIR system, see <http://pair-direct.uspto.gov/>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

Beniyam Menberu

BM

05/29/2005

KAW Williams
KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER